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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,602	03/16/2000	Yasuharu Suda	54490-Z/JPW/DVD	1592

7590 12/08/2003

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/526,602	Applicant(s) SUDA ET AL.	
	Examiner Christopher D RoDee	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Specification

The specification is objected to because it refers to "drawings" or "views" in the Brief Description of the Drawing on page 4 but there is only one drawing or view present. The specification should be amended to refer to the singular drawing and view. Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant claims have been amended to include a limitation that "...the toner particles containing said thermoplastic resin and coloring agent as main components and having the inorganic particles attached to at least surfaces thereof or containing the inorganic particles...". The claims present two alternatives for the inorganic particles location: attached to at least surfaces of the toner particles or that the toner particles contain the inorganic particles.

The instant specification on page 4 states, "It is desirable for inorganic fine particles to be attached to or impregnated in at least the surface region of the toner particle." On page 13

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the specification states, "It is considered reasonable to understand that the inorganic fine particles are attached to or impregnated in at least the surface region of the toner particle so as to produce the ER effect." These appear to be the only passages where the location of the inorganic particles is referenced.

These passages clearly form basis for the inorganic particles attached to at least the surface region of the toner particles. The specification does not, however, provide basis for the limitation that the toner particles contain the inorganic particles. This broader limitation provides for the inorganic particles to be present anywhere in the toner particles and in any amount. For example, the inorganic particles could be present in a small number in the surface of the toner or present in the center of the toner particles with little or no inorganic particles at the surface of the toner. The specification is explicit that in order to form the electrorheological fluid the inorganic fine particles must be impregnated in at least the surface region of the toner particle. The specification does not provide any specific meaning of the term "impregnate". The artisan would give the term its usual and customary meaning.

Webster's II, New Riverside University Dictionary, states for "impregnate" as relevant definition: "3. To fill throughout or saturate." The other definitions provided are not pertinent as they relate to fertilization processes (1. and 2.) or fluids or dyes (4.).

The specification would be understood by the skilled artisan as describing an invention where the inorganic particles fill throughout or saturate the surface region of the toner particles. This is a different invention from the claimed because the claims do not require the degree or amount of inorganic particles in the surface region described by the specification. See discussion of claim scope above. This is particularly the case where an electrorheological fluid is present in the produced liquid toner (see specification citations).

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The claims as presented include new matter and are not described by the specification as filed. The Examiner suggests that the claims be amended to bring them in line with the specification disclosure.

Conclusion

The previous grounds of rejection are withdrawn based upon applicant's amendment to the claims specifying the characteristics of the resultant toner of the process. The art does not suggest that the noted process should be conducted or could produce a liquid toner having properties of an electrorheological fluid.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.


CHRISTOPHER RODEE
PRIMARY EXAMINER

cdr
1 December 2003